

REMARKS

In accordance with the foregoing, the specification and claims 1-4 have been amended, claims 5-22 have been canceled without prejudice or disclaimer, and new claims 23-45 have been added. Claims 1-4 and 23-45 are pending, with claims 1, 23, 26, 27, and 30 being independent. No new matter is presented in this Amendment.

List of References Cited by Applicant

MPEP 609.02 states as follows on MPEP pages 600-148 and 600-149:

The examiner will consider information which has been considered by the Office in a parent application when examining: (A) a continuation application filed under 37 CFR 1.53(b), (B) a divisional application filed under 37 CFR 1.53(b), or (C) a continuation-in-part application filed under 37 CFR 1.53(b). A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

If resubmitting a listing of the information, applicant should submit a new listing that complies with the format requirements in 37 CFR 1.98(a)(1).

Attached hereto is a List of References Cited by Applicant listing the following references that were considered by the Office in Application No. 10/612,415, the parent application of the present application:

US 6,421,726

US 2006/0117344

Also listed in the List of References Cited by Applicant is the following reference that was submitted with the Information Disclosure Statement of January 16, 2004, filed in parent Application No. 10/612,415, and thus was also presumably considered by the Office in parent Application No. 10/612,415:

International Search Report issued on October 30, 2003, in International Application No. PCT/KR03/01306 (3 pages, in English).

A copy of this reference is in the image file wrapper of parent Application No. 10/612,145 as the 3-page document with a Mail Room date of January 16, 2004; a document code of "NPL;" and a document description of "NPL Documents."

Also listed in the List of References Cited by Applicant is US 2002/0078144, which was cited by the Examiner of the present application in the Office Action of March 18, 2009, issued in Application No. 10/777,668 and in the Office Action of March 25, 2009, issued in Application No. 10/777,758; and US 2002/0128061, which was cited by the Examiner of the present application in the Office Action of March 25, 2009, issued in Application No. 10/777,758. Applications 10/777,668 and 10/777,758 are, like the present application, continuations of Application No. 10/612,415. Accordingly, it is submitted that these references should also be considered in the present application, particularly since the Examiner has relied on Application Nos. 10/777,668 and 10/777,758 in provisional nonstatutory obviousness-type double patenting rejections in the Office Action of March 25, 2009, issued in the present application. Accordingly, these references have been listed in the List of References Cited by Applicant attached hereto, it being noted that 37 CFR 1.97 and 1.98 do not provide a specific procedure for an applicant to cite references first cited by an Examiner in a related application.

It is respectfully requested that the Examiner provide with the next Office Action a copy of the List of References Cited by Applicant attached hereto marked by the Examiner to indicate that the cited references have been considered.

Priority

On pages 2-4 of the Office Action of March 25, 2009, the Examiner states that the present application appears to claim subject matter disclosed in prior Application No. 10/612,415 filed on July 3, 2003, and that a reference to the prior application must be inserted as the first sentence of the specification of the present application if the applicants intend to rely on the filing date of the prior application.

The present application is a continuation of Application No. 10/612,415 filed on July 3, 2003, as indicated in item 21 on page 2 of the Continuing (1.53(b)) Utility Patent Application Transmittal filed on February 13, 2004, and as indicated on the filing receipt for the present application mailed May 11, 2004, a copy of which is attached hereto. Accordingly, the first

paragraph of the specification of the present application has been amended to include a reference to parent Application No. 10/612,415 as required by the Examiner. Pursuant to MPEP 201.11(V) (see MPEP page 200-69), a petition and the surcharge under 37 CFR 1.17(t) are not required to make this amendment because the benefit claim contained in item 21 on page 2 of the Continuing (1.53(b)) Utility Patent Application Transmittal was recognized by the Office as shown by its inclusion on the filing receipt mailed May 11, 2004.

On page 4 of the Office Action of March 25, 2009, the Examiner has acknowledged the applicants' claim for priority based on Korean Patent Application Nos. 2002-38880 filed on July 5, 2002, and 2003-436 filed on January 4, 2003, but states that a claim for priority cannot be based on the Korean applications since the present application was filed more than twelve months after the filing dates of the Korean Applications. However, the present application is a continuation of 10/612,415 filed on July 3, 2003, and thus has an effective filing date of July 3, 2003, which is not more than twelve months after the filing dates of the Korean applications.

On page 4 of the Office Action of March 25, 2009, the Examiner states that the applicants have not filed certified copies of Korean Patent Application Nos. 2002-38880 and 2003-436. However, the certified copies were filed on July 3, 2003, in parent Application No. 10/612,415, and it is respectfully requested that the Examiner acknowledge this in the next Office Action.

Claim Rejections Under 35 USC 101

Claims 1-22 have been rejected under 35 USC 101 because the claimed invention is allegedly directed to non-statutory subject matter. The rejection of claims 10-22 is moot since these claims have been canceled in this Amendment. The rejection of claims 1-4 is respectfully traversed:

On pages 5 and 6 of the Office Action of March 25, 2009, the Examiner has allegedly quoted a section of MPEP 2105 as authority for the rejection. However, the material quoted by the Examiner does not appear in the current version of MPEP 2105, which is Eighth Edition, January 2001, Revision 6, September 2007, and appears in MPEP, Eighth Edition, Revision 7, July 2008. Rather, it appears that the Examiner has actually quoted MPEP 2106(IV)(B)(1)(a), Eighth Edition, Revision 3, August 2005, which last appeared on MPEP page 2100-13 of MPEP, Eighth Edition, Revision 4, October 2005. However, there is no MPEP 2106(IV)(B)(1)(a) in the

current version of MPEP 2100, which is MPEP, Eighth Edition, January 2001, Revision 6, September 2007, and appears in MPEP, Eighth Edition, Revision 7, July 2008. In light of this, it is submitted that the Examiner has not established a *prima facie* case of non-statutory subject matter with respect to claims 1-3 and 10-29 because the specific authority for the rejection cited by the Examiner does not actually exist.

The Examiner states as follows:

Claims 1, 5, 6, 7, 9, and 15 are view as having non-functional descriptive material in nature. The limitations of Claim [sic] 1, 5, 6, 7, 9, and 15 just show mere data being presented that does not have any functionality and does not produce a useful, concrete, tangible result. For example, Claim 1 only claims a medium of [sic] merely containing AV data and mark-up/start-up documents which only comprises mere data in a file resulting in not producing a useful, concrete, and tangible result. Thus, it appears as non-statutory.

However, the Examiner did not mention claims 2-4 in explaining the rejection. Accordingly, it is submitted that the Examiner has not established a *prima facie* case of nonstatutory subject matter with respect to these claims.

Furthermore, it is submitted that alleged MPEP 2105 quoted by the Examiner on pages 5 and 6 of the Office Action of March 25, 2009, does not actually support the position taken by the Examiner since it does not mention a "useful, concrete, and tangible result."

However, although the propriety of the rejection is not conceded for at least the reasons discussed above, solely in an effort to eliminate this issue and advance the prosecution of the application, independent claim 1 has been amended to recite "mark-up documents providing functionality enabling the reproducing apparatus to reproduce the AV data in an interactive mode" such that claim 1 and claims 2-4 depending directly or indirectly from claim 1 now clearly do not recite only non-functional descriptive material, and are therefore statutory under 35 USC 101.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-4 under 35 USC 101 because the claimed invention is allegedly directed to non-statutory subject matter be withdrawn.

Claim Rejections Under 35 USC 103

Claims 1-22 have been rejected under 35 USC 103(a) as being unpatentable over Lamkin et al. (Lamkin) (U.S. Patent Application Publication No. 2002/0088011) in view of Berstis et al. (Berstis) (U.S. Patent No. 6,510,458). The rejection of claims 10-22 is moot since these claims have been canceled in this Amendment. The rejection of claims 1-4 is respectfully traversed:

As shown in FIG. 2 of Lamkin, Lamkin discloses displaying DVD-Video content with ROM/HTML content to provide an enhanced DVD experience. The Examiner apparently considers Lamkin's HTML content to be "mark-up documents providing functionality enabling the reproducing apparatus to reproduce the AV data in an interactive mode" as now recited in independent claim 1. The Examiner considers Lamkin's index.htm file that is stored in a directory named common as described in paragraph [0075] to correspond to "a start-up document" as recited in claims 1 and 7.

Berstis discloses a method of filtering a web page by applying a rating label that has a parental level of 0 to 4 for each of four categories (violence, nudity, sex, and language) to a web page. The Examiner is of the opinion that it would have been obvious to apply Berstis' method of filtering a web page to Lamkin's HTML content.

It is submitted that the combination of Lamkin and Berstis proposed by the Examiner does not disclose or suggest the following feature now recited in independent claim 1:

wherein the mark-up comprise a start-up document comprising information about other ones of the mark-up documents corresponding to different parental levels to be displayed depending on a set parental level.

Lamkin's index.htm file that that Examiner apparently considers to correspond to "a start-up document" as recited in claim 1 is described in paragraphs [0101] and [0102] of Lamkin, which state as follows:

[0101] There may be cases where device specific binaries may be included on the DVD disk, but still the general-purpose content. For example, an ITX disk can utilize the directory structure by placing a Windows version of software in the WIN directory, and the Macintosh version of the software in the MAC directory. Upon insertion of the ITX disk, the platform will initiate execution of the appropriate binaries (based on a device specific feature, such as

autorun) and then the binaries will load the index.htm file located in the common directory, the starting point for any general-purpose ITX disk.

[0102] The starting or entry point is the index.htm file, with which resides in the top level of the common directory. It is recommended that all ITX content (with the exception of device-specific binaries) be stored in the common directory. Java Script can then be used to detect platforms and render appropriate HTML pages tailored to specific platforms. The index.htm file will be the background "container" web page while standard playback occurs. This page enables Java Script event handlers to be loaded and activate to handle events during playback. The meta-data of the index.htm file contains the ITX-API version information.

However, it is submitted that nothing whatsoever in Lamkin and Berstis discloses or suggests that Lamkin's index.htm file be modified to comprise information about other mark-up documents corresponding to different parental levels to be displayed depending on a set parental level as would be necessary for the combination of Lamkin and Berstis proposed by the Examiner to arguably suggest the above feature now recited in claim 1.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-4 (i.e., claim 1 discussed above and claims 2-4 depending directly or indirectly from claim 1) under 35 USC 103(a) as being unpatentable over Lamkin in view of Berstis be withdrawn.

Double Patenting Rejections

Claims 1-22 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 7,493,552.

Claims 1-22 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/777,668.

Claims 1-22 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/777,758.

The rejection and two provisional rejections of claims 10-22 are moot since these claims have been canceled in this Amendment. The rejection and two provisional rejections of claims 1-4 are respectfully traversed.

It is noted that claims 1-29 were pending in copending Application No. 10/777,668 when the Examiner issued the Office Action of March 25, 2009, in the present application. Since the Examiner has provisionally rejected claims 1-22 of the present application over only claims 1-14 of copending Application No. 777,668, it is presumed that the Examiner has determined that claims 1-22 of the present application are patentable over claims 15-29 of copending Application No. 10/777,668.

The Examiner provides the following explanation for the rejection and the two provisional rejections:

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations, using varying terminology. Both applications disclose displaying documents along with reproducing AV data in an interactive mode according to a parental level.

However, it is submitted that this explanation does not comply with the requirements of a nonstatutory obviousness-type double patenting rejection set forth in MPEP 804(II)(B)(1), which states as follows on MPEP pages 800-21 and 800-22 (emphasis by underlining added):

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art;
and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations. Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

Here, the Examiner admits that the conflicting claims are not identical, but has not identified the differences between the inventions defined by the conflicting claims, and the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims at issue is anticipated by, or would have been an obvious variation of, the inventions defined in the claims in the patent and the two copending applications.

Furthermore, it is not clear from the Examiner's explanation whether the Examiner considers each one of claims 1-22 of the present application to be unpatentable over each one of claims 1-11 of U.S. Patent No. 7,493,552; over each one of claims 1-14 of copending Application No. 10/777,668; and over each one of claims 1-14 of copending Application No. 10/777,758 (a total of 858 combinations), or whether the Examiner considers each one of claims 1-22 of the present application to be unpatentable over only a specific one or specific ones of claims 1-11 of U.S. Patent No. 7,493,552, claims 1-14 of copending Application No. 10/777,668, and claims 1-14 of copending Application No. 10/777,758, and if so, which specific one or specific ones. The applicants cannot properly analyze the rejection and the two provisional rejections without knowing this.

For at least the foregoing reasons, it submitted that the Examiner has not established a *prima facie* case of nonstatutory obviousness-type double patenting with respect to claims 1-4, and it is respectfully requested that the rejection and the two provisional rejections on the ground of nonstatutory obviousness-type double patenting be withdrawn.

Furthermore, it is submitted that the rejection and the two provisional rejections are moot because claims 1-4 have been extensively amended in this Amendment, such that the rejection and the two provisional rejections are based on outdated versions of claims 1-4.

Patentability of New Claims 23-45

Independent claim 23

It is submitted that Lamkin and Berstis do not disclose or suggest the following feature recited in new independent claim 23:

selecting a mark-up document corresponding to the set parental level from a plurality of mark-up documents corresponding to different parental levels; and
reproducing the AV data in the interactive mode using the selected mark-up document corresponding to the set parental level.

As discussed above in connection with claim 1, the Examiner is of the opinion that it would have been obvious to apply the filtering of a web page taught by Berstis to Lamkin's HTML content. However, according to the abstract of Berstis, "[t]he filtered web page is then blocked from entry in the browser's cache based on the filtering process." Berstis discloses applying a rating label to an entire web page or mark-up document (see column 15, line 19, of Berstis, "[a] specific label applies to a single document"), and determining whether to display the entire web page based on the rating label of the web page and preferences selected by a user. Thus, Berstis teaches displaying or not displaying a web page, rather than selecting a web page corresponding to the user preferences selected by the user from a plurality of web pages corresponding to different user preferences as would be necessary for Lamkin and Berstis to arguably suggest the above features recited in new claim 23.

Independent Claim 26

It is submitted that Lamkin and Berstis do not disclose or suggest the following features recited in new independent claim 26:

identifying a value of each of a plurality of elements of the mark-up document;
individually determining whether to display each of the elements depending on the value of each of the elements and display rule information; and
interpreting the mark-up document to display the mark-up document based on a result of the individually determining.

Berstis teaches filtering an entire web page containing selected key words from being stored in a browser cache (see column 19, lines 6-20) of Berstis. However, Berstis does not disclose or suggest identifying a value of each of the key words, individually determining whether to display each of the key words, and interpreting the web page containing the key words based on a result of the individually determining as would be necessary for Lamkin and Berstis to arguably suggest the above features recited in new claim 26.

Independent claim 27

It is submitted that Lamkin and Berstis do not disclose or suggest the following feature recited in new independent claim 27:

a presentation engine to identify a value of each of a plurality of elements of the mark-up document, individually determine whether to display each of the elements depending on the values of the elements and display rule information, and interpret the mark-up document based on a result of the individually determining.

As discussed above in connection with claim 1, the Examiner is of the opinion that it would have been obvious to apply the filtering of a web page taught by Berstis to Lamkin's HTML content. However, according to the abstract of Berstis, "[t]he filtered web page is then blocked from entry in the browser's cache based on the filtering process." Thus, Berstis discloses applying a rating label to an entire web page or mark-up document (see column 15, line 19, of Berstis, "[a] specific label applies to a single document"), and determining whether to display the entire web page or mark-up document based on the rating label and preferences selected by a user, rather than assigning the rating label to each of a plurality of elements of the web page or mark-up document and individually determining whether to display each of the elements based on the rating label and preferences selected by the user as would be necessary for Lamkin and Berstis to arguably suggest the above feature recited in new claim 27.

Claim 30

It is submitted that Lamkin and Berstis do not disclose or suggest the following features recited in new independent claim 30:

a controller to output a control signal to the reader to control the reader to read AV data and a mark-up document from the data storage medium, the mark-up document comprising interactive contents corresponding to a plurality of different parental levels;

wherein, in an interactive mode, the controller interprets the mark-up document according to a parental level set by the user.

As discussed above in connection with claim 1, the Examiner is of the opinion that it would have been obvious to apply the filtering of a web page taught by Berstis to Lamkin's HTML content. However, Berstis applies a rating label that has a single parental level of 0 to 4 for each of four categories (violence, nudity, sex, and language) to a web page, such that Berstis' web page comprises contents corresponding to a single parental level, rather than to "a plurality of parental levels" as recited in new claim 30.

Furthermore, according to the abstract of Berstis, "[t]he filtered web page is then blocked from entry in the browser's cache based on the filtering process." Thus, Berstis discloses applying a rating label to a web page or mark-up document, and determining whether to display or not display the web page or mark-up document based on the rating label and preferences selected by a user. Thus, if this feature of Berstis were to be applied to Lamkin's HTML content, Lamkin's apparatus would determine whether to interpret or not interpret the HTML content according to the parental level set using the ParentalLevelSelect command on page 11, right column, top, of Lamkin, rather than interpreting the HTML content according to the set parental level as would be necessary for Lamkin and Berstis to arguably suggest the above feature recited in new claim 30.

Conclusion—Patentability of New Claims 23-45

For at least the foregoing reasons, it is submitted that new claims 23-45 (i.e., claims 23, 26, 27, and 30 discussed above and claims 24, 25, 28, 29, and 31-45 depending directly or indirectly from claims 23, 27, and 30) are patentable over Lamkin and Berstis, and an indication to that effect is respectfully requested.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

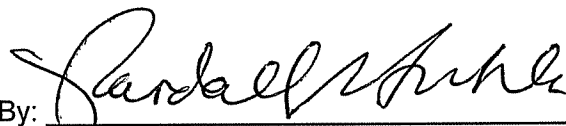
Respectfully submitted,

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Attachments



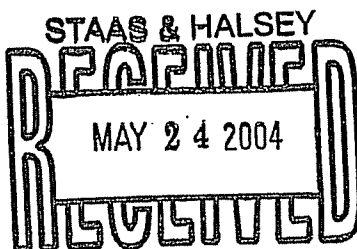
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APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/777,900	02/13/2004	2171	1064	1293.1900C	7	22	6

CONFIRMATION NO. 6095

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FILING RECEIPT



OC000000012579311

Date Mailed: 05/11/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

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Assignment For Published Patent Application

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Domestic Priority data as claimed by applicant

This application is a CON of 10/612,415 07/03/2003

Foreign Applications

REPUBLIC OF KOREA 2002-38880 07/05/2002
 REPUBLIC OF KOREA 2003-436 01/04/2003

If Required, Foreign Filing License Granted: 05/08/2004

Projected Publication Date: 08/19/2004

Non-Publication Request: No

Early Publication Request: No

Title

Method to display a mark-up document according to a parental level, method and apparatus to reproduce the mark-up document in an interactive mode, and a data storage medium therefor

Preliminary Class

707

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Title 37, Code of Federal Regulations, 5.11 & 5.15**

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NOT GRANTED

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